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EXAMINER

HENDRICKS, KEITH D

| ART UNIT | PAPER NUMBER |
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1761

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,672

Applicant(s)

CUPP ET AL.

Examiner

Keith Hendricks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION***Specification***

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Priority

It is noted that this application claims priority to PCT/EP01/00307 and US application 09/483,328. However, it is noted that the subject matter of claims 21-35 does not find support in the 09/483,328 application, and thus the effective priority date for this subject matter is January 10, 2001, the filing date of PCT/EP01/00307.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 7, 13 and 18 recite the phrase "comprising a matrix including...". This renders the claims indefinite, as the metes and bounds of the claim are unclear. The term "including" is not set as to open- or closed-type language. It is suggested that the claims utilize accepted Patent terms, such as "comprising" (open), or "consisting of" (closed). If the invention is to "comprise" the elements, it need not "include" them, as well. If the food is to "comprise" the matrix, then the matrix should also "comprise" the recited elements.

Claim 18 further complicates this issue by using the phrases "having" and "including", in addition to "comprising", which render the claim indefinite, as it is unclear as to what is encompassed by these terms. "Having" is traditionally viewed as closed Patent language.

It is suggested that the dependent claims also utilize the same corresponding terms as in the independent claims.

Claim 20 is indefinite for the phrase "allowing the pet to chew". This is not active Patent language, and it is unclear as to how one is to "allow" a pet to chew a food, versus "allowing" a pet to do

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any other activity. It is suggested that positive, active language be utilized, such as feeding an animal, or orally administering the chew food to an animal.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

i) Claims 1-5, 7-11, 13-16, 18-20, 26, 29, 32 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Simone et al. (US PAT 5,407,661).

Simone et al. disclose an edible pet food product comprising a matrix which comprises cellulose (insoluble) fiber, gelatinized starch and protein components (see col. 3), and a humectant such as glycerin (col. 5). At column 3, Simone et al. also teach that the cellulosic fiber materials of the pet food are used in the range of about 20-50% by weight of the final product (i.e. cellulosic materials such as corn cob, etc., not necessarily cellulose levels of 20-50%). Both wheat and corn sources are also used as the starch. Given that wheat generally contains 2.3- 5.6% total dietary fiber, with 1.7% of that insoluble, including cellulose, and corn flour has 15% insoluble fiber, including cellulose, (reference to standard textbook in the art, for example, pg. 481, 484. Lorenz et al. "Handbook of Cereal Science and Technology", Dekker Press, 1991), and used in the amounts provided, this would be expected to give the product an inherent cellulose, and/or other insoluble fiber, level within the range instantly claimed (for example, with corn, 15% of 20%-50% of the total would equal 3%-7% of the total weight as insoluble fiber.). The dried sections of this product were then subdivided into pieces which were 2.75 inch (69.85 mm) in length, 1 inch (25.4 mm) wide, and .25 - .75 inch (6.35 - 19 mm) thick, for the final product (col. 7-8). The reference does not provide specific numbers for the density of the chew food, but at column 5 states that "the extruded chew product of the present invention is a solid composition having a cellular matrix and a chewy non-brittle texture which is not readily fractured when chewed by the animal". As each of the

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other claimed factors are the same as the claimed invention, it may be reasonably concluded that, as an inherent property of the disclosed pet chew product, the density of the product of Simone et al. was within the instantly-claimed range of less than 20.5 lbs per cubic foot (328 kg per cubic meter) or 18 lbs/ft³ (288 kg/m³). Thus, the claimed invention is anticipated by the reference.

ii) Claims 7-12, 18, 28-29 and 34-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Gellman et al. (US PAT 4,743,460).

Gellman et al. disclose a dry soft canine biscuit comprising a denatured/gelled protein source and carbohydrate source (farinaceous and/or vegetable material), with insoluble fiber, and optionally about 5-15% of a humectant, including glycerin (abstract; col.'s 7-8). The denaturization and gelling is formed from the heat during extrusion. The final biscuit pieces have a moisture content of "less than or equal to about 15 percent by weight and preferably about 10 to about 12 percent by weight" (col. 9, lines 39-43). The final canine biscuit product has a preferred thickness of about ½ inch [12.7 mm] (col. 5, line 28), and was cut into 1.25 inch (31.75 mm) length cylinders (col. 13, line 40). At column 12, the reference states that when the composition contains vegetable protein to replace some or all of the meat protein, the product will have "a bulk density of about 15 to about 20 lbs. per cubic foot". Insoluble fiber is not specifically mentioned as an ingredient; however, the farinaceous materials described at column 10 naturally contain some amount of fiber. For example, wheat generally contains 2.3- 5.6% total dietary fiber, with 1.7% of that insoluble, including cellulose. Corn flour has 15% insoluble fiber, including cellulose (reference to standard textbook in the art, for example, pg. 481, 484. Lorenz et al. "Handbook of Cereal Science and Technology", Dekker Press, 1991). Although this does not reach the threshold of "about 2% to about 15%" (instant claims 4,10, and 16), the instantly-rejected claims are anticipated by the reference. Note that as the reference teaches the optional use of the humectant, this reads upon the instant claims, "wherein the product does not include a humectant."

iii) Claims 1-20, 21, 26, 29, 32 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Hand et al. (US PAT 5,431,927)

Hand et al. teach of a chewy dry pet food, which is in the form of pellets, for both cats and dogs (col. 1). The product comprises a cohesive structural matrix containing proteins, starches, carbohydrates and fiber such as cellulose (col. 5). A typical range of the cellulose fiber is shown to be in the range of 10-25% (column 4,5; claims 2,5,7, 11). The starch is gelatinized ("plasticized"), and as the product is extruded at a temperature of about 240 degrees to 320 degrees F, inherently some or all of the protein

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source would have been denatured. The dried pellets thus produced have a moisture level of about 5-11% (col. 2, col. 7-8). At column 5, the reference states that the product may be in any of several shapes, and is preferred as a disc-shaped pellet having a thickness of about 0.32 to 0.70 inch (about 8mm to 17mm), and a length/width "diameter of about 0.7 to about 1.2 inch" (17.7 - 30.48 mm). The example product was cut into about 12mm (0.5 inch) thick pellets and fed to dogs. Finally, the product has a density ranging from "about 10 to about 35 lbs/ft³". Hand et al. does not teach the use of a humectant.

iv) Claims 21, 24-25, 27-28, 30-31 and 33-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang (US PAT 6,455,083).

Wang discloses an "edible thermoplastic and nutritious pet chew", which contains about 30-50% protein, about 20-50% starch and preferably "from about 8 to 15% water" (col. 7, ln. 63-64). The starch and/or proteins may be gelatinized, and the proteins sources include corn, such as gluten (bottom col. 5). The chew may be made to have lengths of 4-12 inches, with segments of one-quarter inch to one inch (1 inch = 25.4 mm), or more (col. 9, lines 29-34). The cross section shape may be formed into that of "a star, an oval", etc. (mid col. 4; col. 9, lines 19-22).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 13-17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gellman et al.

Gellman et al. is taken as cited above.

Although Gellman et al. do not specifically teach feeding their chew product to animals, it would have been obvious to one of ordinary skill in the art to have performed this step, given the nature of the pet food product and the disclosure of the reference therein. Further, as the reference stated that the soft particles containing the denatured/gelled protein source and carbohydrate source, etc., were to be incorporated to provide a dry, soft canine biscuit, and that at column 15 the reference stated that the "soft dough and particles were then formed... into various shapes" to create the biscuits, it would have been

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obvious to one of ordinary skill in the art to have varied the final biscuit dimensions such that they were of a larger size in the common ranges of traditional canine chew products and biscuits. The reference taught that the product had a preferred thickness of about ½ inch [12.7 mm] (col. 5, line 28), and was cut into 1.25 inch (31.75 mm) length cylinders (col. 13, line 40), and thus it would have been obvious to have varied the width of the biscuit in accordance with the other dimensions, especially to form "various shapes" as taught.

Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hand et al., taken as cited above, in view of Schommer et al. (US PAT 5,887,749).

Schommer et al. disclose a food container for mixing both wet and dry pet foods. At column 1, it is stated that it was known that pets prefer both wet and dry foods, and that "in the past, pet owners have purchased dry pet food and canned wet food in separate containers, and then mixed them to feed their pet." The patent teaches the mixing of dry and wet pet foods. Thus, it would have been obvious to one of ordinary skill in the art to have performed this commonly-known method of pet food mixing, for example with the known food of Hand et al. The selection of the amount of both dry and wet foods would not have involved an inventive step, and would have been well within the ordinary level of skill in the art to have provided an approximately equal balance of wet food and dry food.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

i) Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 09/154,646.

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ii) Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 10/052,949.

iii) Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of copending Application No. 10/037,941

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both directed to pet food chew products (and methods of use) of various sizes, with the same density properties and overlapping ingredients of denatured proteins and starches, insoluble fibers, etc.


This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (703) 308-2959. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703) 308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9565 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


KEITH HENDRICKS
PRIMARY EXAMINER